

REMARKS/ARGUMENTS

The claims were rejected under 35 U.S.C. 103 as being obvious over Bechtel. That is, claims 2, 3, 5, 7, 8 and 16 – 21 were rejected under 35 U.S.C.103 (a) as unpatentable over Bechtel, No. 5,371,991. Claim 16 also was objected to as to form. Claims 22 - 24 are newly presented and are all read on the previously elected species shown in Figures 1 - 3. The claims, as amended and presented are believed to correct the formal deficiencies noted by the Examiner and to be non obvious over the art of record, whether that art is considered singly or in combination.

In particular, Claim 16 is amended to positively recite the merchandise display and is more specific as to how the advertising panel is associated both the merchandise display and the clip, the clip functioning to attach the panel in a particular spatial relationship with the rods of the display.

Claims 17 – 23 are all dependent upon Claim 16 and, with respect to claims 22 and 23, more specifically define the spatial relationship provided by the invention, which relationship is not shown or described in the art relied upon by the Examiner. The claims are allowable with the base claim.

Claim 24 is a Jepson claim and specifically sets out the spatial relationship provided by the present invention in a merchandise display. As indicated above, all of the amended and newly presented claims are directed toward the species of the invention shown in Figures 1 - 3, and previously elected by Applicant.

It is respectfully suggested that the Examiner is reading more into Bechtel than is permitted under the law. The Examiner is correct in that Bechtel teaches a rebar clamp assembly. But nothing in Bechtel teaches one skilled in the art how to accomplish applicant's invention. In particular, all of the art relied upon by the Examiner shows and describes clips which connect two parts at right angles to one another. Nothing in any of the art cited shows describes or even vaguely intimates how to construct a clip for use in conjunction with a merchandise display having an advertising panel associated with it, the display being formed by a plurality of structural members which in turn define an opening with which the advertising panel is aligned. That is to say, the advertising panel generally lies in the same plane as the opening defined by the structural members. All of the independent claims, either as presently amended or as newly presented include language which makes this distinction clear. That distinction is not shown in the art, and certainly not obvious from it, unless the Examiner employs the hindsight knowledge provided by applicant's disclosure.

Applicant also respectfully traverses the Examiner's statement, at page 4 of the rejection, which states in pertinent part, "However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the first distance dimensioned size is greater than the second distance dimensioned size because Applicant does not disclose that having the first distance dimensioned size greater than the second distance provides an advantage or solves any stated problem or is ready for a particular purpose." The specification is replete with references to the advantages of applicant's design. In particular, in the paragraph bridging pages 1 & 2 of the specification, Applicant states "The

present invention is designed to obviate and overcome many of the disadvantages and shortcomings associated with presently available methods and construction of fixing or securing cutouts, sheets, displays, or panels to a display tower. In particular, the present invention is a clip that is designed and constructed to secure or attach a panel to a display tower with a clip being capable of being easily disassembled or removed from both the panel and the display tower. Moreover, the clip of the present invention may be easily positioned along the panel and the display tower for proper alignment of the panel within or on the display tower.” Further, in the objects of the invention, Applicant repeatedly states that: “Another object of the present invention is to provide a clip that is easy to use and may be removed or positioned along a panel in a display device.” And “A further object of the present invention is to provide a clip that can be secured to and released from a post, a rod, or a pull.” Likewise, “A further object of the present invention is to provide a clip that may be used to prepare and construct a display. Again, “Another object of the present invention is to provide a clip that strong and flexible and has a unitary construction.” Further, at page 5, the specification states “The arms 30 and 32 are spaced apart from each other to allow a sign or display to be captured within or between the arms 30 and 32. The arms 30 and 32 may be sized and shaped to receive a particular thickness of a panel, size, or a display. The end portions 34 and 36 facilitate directly in the position of any sign or display within the arms 30 and 32. The interior surfaces 40 and 44 are used to hold or grasp a sign or a display. The exterior surfaces 38 and 42 serve as finger grips to assist in positioning the arms 30 and 32 on a sign or a display.” A more compelling statement or statements setting forth the importance of the construction or the problems solved by that construction is hard to imagine.

Applicant has devised an extremely successful device used to in conjunction with displays or display towers and attention attracting items in the form of small signs or panels often used by department stores and similar merchants to attract the attention of their customers to a particular display of goods. The art is devoid of similar structure or a similar result. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." MPEP § 2143. Further, "a statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP §2143.01(IV) (emphasis in original).

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01(I) The test for

an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." Nothing in the art relied upon by the Examiner shows a clip which positions a panel along the opening defined by the member plurality, and none of the clips cited by the Examiner accomplish that result. The references must be considered as a whole, and "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 US ___, 82 USPQ2d 1385, 1396 (2007), quoting with approval *In re Kahn*, 78 USPQ2d 1329, 1336, 441 F.3d 977, 988 (Fed. Cir. 2006).

The remaining claims all are dependent claims. Appellant respectfully points out that *The Manual of Patent Examining Procedure* at § 2143.03 states, "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)." Because independent claims are allowable over the art of record, Appellant submits, that under the relevant law, the dependent claims also are allowable without an additional showing of non-obviousness.

Appellant has made an elegantly simple invention. The simplicity of the invention does not indicate obviousness, and in fact "the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made." *In re Sporck*, 301 F.2d 686, 133 U.S.P.Q. 360, 363 (CCPA, 1962).

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Reconsideration of and withdrawal of the rejection under 35 U.S.C. 103 and passage of the case to issue are respectfully requested.

Respectfully Submitted,

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